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10/651,878	08/29/2003	Patrick Engelking	D02-065/01466-00/US	9353
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EXAMINER				
NGUYEN, TAN D				
ART UNIT		PAPER NUMBER		
3689				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/651,878

Applicant(s)

ENGELKING ET AL.

Examiner

Tan Dean D. Nguyen

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-9, 15, 18-21, 23-25, 27-34, 36-54, 56-67, 69-75 and 77-83 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-9, 15, 18-21, 23-25, 27-34, 36-54, 56-67, 69-75 and 77-83 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-840)
Paper No(s)/Mail Date _____
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

I. Response to Amendment

1. The amendment of 6/3/10 has been entered.

II. Claim Status

2. Claims 1, 4-9, 15, 18-21, 23-25, 27-34, 36-54, 56-67, 69-75 and 77-83 are pending. Current pending claims comprise 6 independent claims sets:

- 1) System¹: 1, 4-9;
- 2) Computer readable storage media (CRSM): 15, 18-19;
- 3) Method¹: 20-21, 23-25, 27-34, 36-46,
- 4) CRSM²: 47-54, 56-61,
- 5) CRSM³: 62-67, 69-75, and 77-82, and
- 6) CRSM⁴: 83.

Claims amended herein: 1, 9, 15, 19, 20, 29, 46, 47, 62, 82, 83.

Claims canceled herein: 2-3, 10-14, 16-17, 35, 55, 76 and 84-85.

Claims canceled previously: 22, 26, 68 and 86.

As of 6/3/2010, independent system claim 1 is as followed:

1. (Currently Amended) A system for identifying a business organization transformation opportunity for a business organization that provides a product or service, comprising:

(1) a microprocessor configured to

a) receive a plurality of business organization data inputs corresponding to a first state of a first business organization function of the business organization, wherein the first business organization function is a human resources function including human resource services .and the data inputs include full-time equivalents (FTEs) for employees and costs for human resources,

b) analyze at least one of the business organization data inputs by comparing the at least one business organization data input to at least one industry threshold value,

c) determine a performance matrix of the business organization based on the comparison,

d) model a business organization transformation opportunity scenario that includes a second state of the first business organization function, different than the first state, responsive to the analysis,

wherein the business organization transformation opportunity scenario is at least one of a broad-outsourcing transformation scenario and a mix scenario including a mix of outsourcing and internal transformation scenario, and

the broad-outsourcing transformation scenario includes a scenario whereby the human resource services are outsourced and the mix scenario includes a scenario whereby at least one of the human resource services are outsourced and at least one of the human resources are not outsourced,

e) calculate, based on the model, a transition of the FTEs and the costs to an outsourcer as a result of implementing at least one of the broad-outsourcing scenario and the mix scenario transition, and

f) determine an effect on the performance matrix of transforming the business organization to the second state based on the model; and

2) a hardware display coupled to the microprocessor, the hardware display configured to present a user interface that includes the transition of the FTEs and costs to the outsourcer as a result of implementing at least one of the broad-outsourcing scenario and the mix scenario transition ~~of information associated with the modeled business organization transformation opportunity scenario~~ and includes the effect on the performance matrix.

Note: for convenience, numeral (1)-(2) are added to the beginning of each element.

Finding of Facts

1) The term “**threshold**” is defined as:

Main Entry: **thresh-old**

Pronunciation: \ˈthresh-,hōld, ˈthre-,shōld\

Function: *noun*

Etymology: Middle English *threshold*, from Old English *threscwald*; akin to Old Norse *threskjöldr* threshold, Old English *threscan* to thresh

Date: before 12th century

1 : the plank, stone, or piece of timber that lies under a door : SILL

2 a : GATE, DOOR **b** (1) : END, BOUNDARY; *specifically* : the end of a runway (2) : the place or point of entering or beginning : OUTSET <on the threshold of a new age>

3 a : the point at which a physiological or psychological effect begins to be produced <has a high threshold for pain> **b** : a level, point, or value above which something is true or will take place and below which it is not or will not

2) The term "**matrix**" is defined as:

Main Entry: **ma·trix**

Pronunciation: \ˈmā-triks\

Function: *noun*

Inflected Form(s): *plural* **ma·tri·ces** \ˈmā-trə-,sēz, ˈma-\ or **ma·trix·es** \ˈmā-trik-səz\

Etymology: Latin, female animal used for breeding, parent plant, from *matr-*, *mater*

Date: 1555

1 : something within or from which something else originates, develops, or takes form

2 a : a mold from which a relief surface (as a piece of type) is made **b** : DIE **3a**(1) **c** : an engraved or inscribed die or stamp **d** : an electroformed impression of a phonograph record used for mass-producing duplicates of the original

3 a : the natural material (as soil or rock) in which something (as a fossil or crystal) is embedded **b** : material in which something is enclosed or embedded (as for protection or study)

4 a : the extracellular substance in which tissue cells (as of connective tissue) are embedded **b** : the thickened epithelium at the base of a fingernail or toenail from which new nail substance develops

5 a : a rectangular array of mathematical elements (as the coefficients of simultaneous linear equations) that can be combined to form sums and products with similar arrays having an appropriate number of rows and columns **b** :

something resembling a mathematical matrix especially in rectangular arrangement of elements into rows and columns **c** : an array of circuit elements (as ~~diodes~~ and transistors) for performing a specific function
6 : a main clause that contains a subordinate clause

See *Merriam-webster Online Dictionary*, available at <http://www.merriam-webster.com/dictionary/event> (visited on January 30, 2010).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims 20-21, 23-25 and 27-34, and 36-46** (method) are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that a § 101 process must:

(1) be tied to a particular machine or apparatus or

(2) transform underlying subject matter (such as an article or materials) to a different state or thing. See *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

(a) To qualify as a § 101 statutory process, the claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

(b) There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

(c) Here, applicant's method steps fail the first prong of the new test because the only tie to a computer occurs in only one step, analyzing step, which does not appear to be critical to the claimed invention. The critical steps to the claimed invention appear to be involved with the "modeling" step, "calculating a transition " step and "determining an effect" step and "displaying" step.

(d) Further, applicant's method steps fail the second prong of the test because the claimed steps do not result in an article being transformed from one state to another. There is no transformation occurring in the claims for a physical object or substance or data that represents physical objects or substances.

Claim Rejections - 35 USC § 112

5. Claims 20-21, 23-25, 27-34, 36-46 (method) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In independent claim 20, the phrase "calculate, based on the model, a transition of ..." is vague because the rest of the verbs in the claim are using "verb+ing" form so it's not clear whether this phrase "calculate" is a part of the verbs for carrying out the actions in the claim?

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 4-9 (system), 15,18-19 (CRSM), 20-21, 23-25, 27-34, 36-46 (method), 47-54, 56-61 (CRSM), 62-67, 69-75, 77-82 (CRSM), and 83 (CRSM) are rejected under 35 U.S.C. 103(a) as obvious over (1) MORGAN et al in view of (2) PARKER et al.

Similarly, MORGAN et al fairly discloses a system, method, and CRSM for identifying a business organization transformation opportunity (trend, forecast, benchmark, site comparison, etc,) for a business organization that provides a product or service, comprising:

1) a microprocessor configured to

a) receive a plurality of business organization data inputs corresponding to a first state of a first business organization function of the business organization, wherein the first business organization function is a human resources function including human resource services and the data inputs include full-time equivalents (FTEs) for employees and costs for human resources,

{see Figs. 1, 2, element 74 "**user input**", col. 7, lines 17-67 "**...forecasting or scenario, ...projections...changes in full time equivalents (FTE)..** , col. 18 "**... (FTE)...**", col. 19}

b) analyze at least one of the business organization data inputs by comparing the at least one business organization data input to at least one industry threshold value (benchmark, best value, average value, etc.),

{see Figs. 1, "**Site Comparison**", col. 7, col. 19 "**Site Comparison Service...**"}

c) determine a performance matrix of the business organization based on the comparison,

{see Figs. 4, 5, 6, 7, 18A, 18B, Table A, B, J, col. 19 "**Matrix report**"}

d) model a business organization transformation opportunity scenario that includes a second state of the first business organization function, different than the first state, responsive to the analysis,

{see col. 7 "...In a forecasting or budget-generating scenario, ...", col. 19}

e) calculate, based on the model, a transition of the FTEs and the costs to a scenario, and

{see Figs. 7, 13-14, 18A, 18B, 19, cols. 7, 8 "expressed in full-time equivalents (FTE)...", cols. 14, 17, 19}

f) determine an effect on the performance matrix of transforming the business organization to the second state based on the model; and

{see Figs. 13-14, 18A, 18B, cols. 17-18, 19}

2) a hardware display coupled to the microprocessor, the hardware display configured to present a user interface that includes the transition of the FTEs and costs to the event scenario as a result of implementing at least one of the scenario and the scenario transition and includes the effect on the performance matrix.

{see Figs. 1, 2, 16, 17, 18A, 18B, cols. 17-19}

MORGAN et al fairly teaches the claimed invention except for the type of scenario, or “wherein the business organization transformation opportunity scenario is at least one of a broad-outsourcing transformation scenario and a mix scenario including a mix of outsourcing and internal transformation scenario, and

the broad-outsourcing transformation scenario includes a scenario whereby the human resource services are outsourced and the mix scenario includes a scenario whereby at least one of the human resource services are outsourced and at least one of the human resources are not outsourced”.

In another system/method for analyzing organization business strategies, **PARKER et al** discloses various outsourcing strategies and scenarios and business matrix and pricing models relating to each scenario and matrix to provide effective outsourcing and facilitating the delivery of the services {see pars. [0032-0037], [0156-0162], [0202-0203], Figs. 1E, Fig. 2, 3,8, 15, 17, 19 and 23}.

Therefore, it would have been obvious to a person having ordinary skill in the art (herein after as “PHOSITA”) at the time of the invention was made to modify the business scenario of MORGAN et al to include outsourcing scenario and mix scenario as taught by PARKER et al to comply to “a standard corporate strategy” [0006] and using a value chain approach which facilitates the creation of customer-centric, end-to-end delivery scenarios as taught by PARKER et al on pars. [0006, 0032-0037]}.

As for dep. claims 4, 9 (part of 1 above), 18, 19 (part of 15), which deal with types of result features, i.e. a cost savings estimate, cost information, IT information, etc., these are taught by MORGAN et al as shown in Tables I, F and J and PARKER et al Figs. 1A, 8 and 9. Alternatively, the use of any other business functions or features, the use/applying of the same analysis and modeling system for any other business functions or features would have been obvious as mere using other similar features to achieve similar results.

As for dep. claims 5-6 (part of 1 above) which deal with types of business data inputs, etc., these are taught in Figs. 1, 2 and cols. 4-5. As for the use of any other business functions or features, the use/applying of the same analysis and modeling system for any other business functions or features would have been obvious as mere using other similar features to achieve similar results.

As for dep. claims 7-8 (part of 1 above) which deal with types of execution of the microprocessor, these are taught in MORGAN et al Figs. 1-2, 46-49, cols. 3-4.

As for claims 21, 23-25, 27-28 (part of 20 above) which deal with various data input parameters, these are taught in MORGAN et al Figs. 1-2, cols. 3-5, PARKER et al Figs. 2, 8 and 10.

As for claims 29-34 (part of 20 above) which deal with result summary parameters and modeling scenarios, these are fairly taught in MORGAN et al Tables E, J, and PARKER et al 12, 15, 17, 19-21.

As for claims 36-43 (part of 20 above) which deal with result summary parameters and modeling scenarios, these are fairly taught in MORGAN et al Tables E, J, and PARKER et al 12, 15, 17, 19-21.

As for claims 44-46 (part of 20 above) which deal with analysis results parameters and modeling scenarios, these are fairly taught in MORGAN et al Tables E, J, and PARKER et al 12, 15, 17, 19-21.

As for dep. claims 48-54, 56-61 (part of 47 above), which basically have similar limitations as in dep. claims 21, 23-25, 27-34 and 36-46 (part of 20 above), they are rejected for the same reasons set forth in the rejections of claims 21, 23-25, 27-34 and 36-46 above.

As for dep. claims 63-67, 69-75 and 77-82 (part of 62 above), which basically have similar limitations as in dep. claims 21, 23-25, 27-34 and 36-46 (part of 20 above), they are rejected for the same reasons set forth in the rejections of claims 21, 23-25, 27-34 and 36-46 above.

Note for the CRSM claims 15, 47, 62, and 83, they do not contain the phrase "the computer program comprising a routine set of instructions which when executed by a computer machine cause the computer machine to perform the steps of: "xxxx". So they are merely considered as "capable of" carrying the steps of and the software stored on a disk" and the CRSM of MORGAN et al /PARKER et al is capable of having all of the features as claimed if they are not included.

Response to Arguments

1. Applicant's arguments with respect to claims 1-9 (system), 15-19 (CRSM), 20-21, 23-25, 27-46 (method), 47-61 (CRSM), 62-67, 69-82 (CRSM), and 83-85 (CRSM) on 11/13/09 have been considered but are moot in view of the new ground(s) of rejection which are caused by applicant's amendment of the claims.
2. 1) As for the statement with respect to the 101 issue, it's not fully persuasive, because the issue at interview is "prima facie" in nature and upon further analysis of the claim, the proposed amendment is not found to be totally convincing for overcoming the 101 issue as indicated above.

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

4. 1) US 2004/0 039 619, by Zarb, fairly teaches business strategies analysis including outsourcing resources, using of benchmark, scenarios, etc. {see par. 0100}.
5. 1) US 2002/0 120 486, by Thompson, fairly teaches business strategies analysis including outsourcing resources, using of benchmark, scenarios, FTE, etc. {see par. [0006-0013]}.

No claims are allowed.

6. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

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or faxed to **571-273-8300**.

Hand delivered responses should be brought to the

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1. In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail CustomerService3600@uspto.gov.

2. Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday. Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805. The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689